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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/10/2000

Steven D. Jensen

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22913

7590

02/14/2011

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/710,181	Applicant(s) JENSEN ET AL.	
	Examiner ALTON N. PRYOR	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41,42,44-48,50-54,56-63,65-68,70-87 and 91-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41,42,44-48,50-54,56-63,65-68,70-87,91-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Below are the rejections derived from a pre-appeal conference.

Applicant's arguments, see paper, filed 10/28/10, with respect to the claims have been fully considered and are persuasive. The previous rejection under 103(a) is withdrawn. The previous Obviousness type double patenting rejections are maintained and two obviousness type double patenting rejections are being reinstated from office action of August 2003.

Applicant's arguments with respect to claims in previous 103(a) rejection have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (USPN 5851512; 12/22/98), Fischer teaches a dental composition comprising a desensitizing agent such as 0.1 – 10% potassium nitrate (column 3 line 35- column 4 line 36, column 8 lines 51-67). Fischer teaches fluoride salts such as sodium fluoride (column 9 lines 1-17), peroxides such as carbamide peroxide and hydrogen peroxide (column 9 lines 36-47) and antimicrobial agents (tetracycline) can be added to the composition for anticariogenic activity, bleaching effect, and antimicrobial activity, respectively (column 4 lines 38-51). Example

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8 used 10% urea peroxide (column 8 line 62 – column 15 line 12). Glycerine, propylene glycol and carboxypolymethylene (tackifying agents) can be added so that the composition adheres to teeth (column 8 lines 1-22). Water may also be added to the composition in a range of 0-50% by weight of the dental composition. (column 8 lines 11-22). Fischer teaches that EDTA or citric acid can be added to the dental composition in order to preserve stability of the dental composition (column 9 lines 28-35. Fischer teaches a method of treating teeth with the dental composition (column 11 line 54 - column 12 line 7). Fischer teaches a method of applying the dental composition to teeth by using a dental tray. The tray can be left on teeth for 15 minutes, one hour, or for any desire time period (column 11 line 54 - column 12 line 7). The method does not require brushing for the dental composition to work (column 5 lines 44-57). Fischer differs from the instant invention in that Fischer does not explicitly teach an invention to a non-abrasive composition or a dental composition that is substantially abrasive free. However, Fischer does not teach anywhere in the specification that his invention comprises an abrasive. Therefore, it is obvious that Fischer's invention is non-abrasive or substantially abrasive free.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (USPN 5985249; 11/16/99), Fischer teaches a dental composition comprising a desensitizing agent such as 0.1 – 10% potassium nitrate (column 8 line 63- column 9 line 12). Fischer teaches fluoride salts such as sodium fluoride (column 9 lines 13-26), peroxides such as carbamide peroxide and hydrogen peroxide (column 9 lines 46-57) and antimicrobial agents (tetracycline) can be

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added to the composition for anticariogenic activity, bleaching effect, and antimicrobial activity, respectively (column 9 lines 27-37). Example 8 used 10% urea peroxide (column 15 lines 14-31). Glycerine, propylene glycol and carboxypolymethylene (tackifying agents) can be added so that the composition adheres to teeth (column 7 line 62 – column 8 line 6). Water may also be added to the composition in a range of 0-50% by weight of the dental composition. (column 8 lines 7-18). Fischer teaches that EDTA or citric acid can be added to the dental composition in order to preserve stability of the dental composition (column 9 lines 38-45). Fischer teaches a method of treating teeth with the dental composition (column 11 line 49 - column 12 line 19). Fischer teaches a method of applying the dental composition to teeth by using a dental tray. The tray can be left on teeth for 15 minutes, one hour, or for any desire time period (column 11 line 54 - column 12 line 7). The method does not require brushing for the dental composition to work (column 5 lines 31-40). Fischer differs from the instant invention in that Fischer does not explicitly teach an invention to a non-abrasive composition or a dental composition that is substantially abrasive free. However, Fischer does not teach anywhere in the specification that his invention comprises an abrasive. Therefore, it is obvious that Fischer's invention is non-abrasive or substantially abrasive free.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (USPN 6306370; 10/23/01), Jensen et al. teach a dental composition comprising a desensitizing agent such as 0.1 – 10% potassium nitrate (claim 2). Jensen et al. teach fluoride salts such as sodium fluoride

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(claim 9), peroxides such as carbamide peroxide and hydrogen peroxide (claim 10) and antimicrobial agents (tetracycline) can be added to the composition for anticariogenic activity, bleaching effect, and antimicrobial activity, respectively (claims 4-8). Glycerine, propylene glycol and carboxypolymethylene (tackifying agents) can be added so that the composition adheres to teeth (claims 4-8). Water may also be added to the composition in a range of 0-50% by weight of the dental composition. (column 8 lines 34-47). Jensen et al. teach that EDTA or citric acid can be added to the dental composition in order to preserve stability of the dental composition (claim 12). Jensen et al. teach a method of treating teeth with the dental composition (claims 15-23). Jensen et al. teach a method of applying the dental composition to teeth by using a dental tray. The tray can be left on teeth for 15 minutes, one hour, or for any desire time period (claims 15-23). The method does not require brushing for the dental composition to work (claim 15). Jensen et al. teach that the dental composition is substantially abrasive free (claim 1). Jensen et al. differ from the instant invention in that Jensen et al. do not explicitly exemplify an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such an invention.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (USPN 016309625; 12/22/98), Jensen et al. teach a dental composition comprising a desensitizing agent such as 0.1 – 7% potassium nitrate (claim 2). Fischer teaches fluoride salts such as sodium fluoride (column 10 lines 1-23), peroxides such as carbamide peroxide and hydrogen peroxide (column 9 lines 40-54) and antimicrobial agents (tetracycline) can be added to the

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composition for anticariogenic activity, bleaching effect, and antimicrobial activity, respectively (column 10 lines 1-23). Glycerine, propylene glycol and carboxypolymethylene (tackifying agents) can be added so that the composition adheres to teeth (column 8 lines 20-33). Water may also be added to the composition in a range of 0-50% by weight of the dental composition. (column 8 lines 34-47). Jensen et al. teach that EDTA or citric acid can be added to the dental composition in order to preserve stability of the dental composition (column 9 lines 55-67). Jensen et al. teach a method of treating teeth with the dental composition (column 2 line 64 - column 3 line 14). Jensen et al. teach a method of applying the dental composition to teeth by using a dental tray. The tray can be left on teeth for 15 minutes, one hour, or for any desire time period (column 12 line 54 - column 13 line 9). The method does not require brushing for the dental composition to work (column 5 lines 44-57). Jensen et al. teach that the dental composition is substantially abrasive free (column 2 lines 54-63). Jensen et al. differ from the instant invention in that Jensen et al. do not explicitly exemplify an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such an invention.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (USPN 6368576; 04/9/02), Jensen et al. teach a dental composition comprising a desensitizing agent such as up to 10% potassium nitrate (claim 10). Jensen et al. teach fluoride salts such as sodium fluoride (claim 9), peroxides such as carbamide peroxide and hydrogen peroxide (claim 13) and antimicrobial agents (tetracycline) can be added to the composition for anticariogenic

activity, bleaching effect, and antimicrobial activity, respectively (claims 15,16).

Glycerine, propylene glycol and carboxypolymethylene (tackifying agents) can be added so that the composition adheres to teeth (claim 12). Water may also be added to the composition in a range of 0-50% by weight of the dental composition. (column 8 lines 43-56). Jensen et al. teach that EDTA or citric acid can be added to the dental composition in order to preserve stability of the dental composition (claim 14). Jensen et al. teach a method of treating teeth with the dental composition (claims 1-20). Jensen et al. teach a method of applying the dental composition to teeth by using a dental tray.

The tray can be left on teeth for 15 minutes, one hour, or for any desire time period (claims 1-20). The method does not require brushing for the dental composition to work (claim 17). Jensen et al. teach that the dental composition is substantially abrasive free (claims 1 and 20). Jensen et al. differ from the instant invention in that Jensen et al. do not explicitly exemplify an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12,15,16 of U.S. Patent No. 5851512. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent discloses a composition comprising a desensitizing agent (potassium nitrate, citric acid), a tackifying agent (carboxypolymethylene), cetyl pyridinium bromide, and a bleaching agent. USPN '512 does not require an abrasive. Fischer differs from the instant invention in that Fischer does not claim an invention to a non-abrasive composition or a dental composition that is substantially abrasive free as claimed. However, Fischer does not teach anywhere in the specification that his invention comprises an abrasive. Therefore, it is obvious that Fischer's invention is non-abrasive or substantially abrasive free. Fischer differs from the instant invention in that Fischer does not make claim to an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Fischer does suggest such an invention.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7,10-20 of U.S. Patent No. 6368576. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent discloses a method of applying a composition comprising a desensitizing agent (potassium nitrate, citric acid), a tackifying agent

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(carboxypolymethylene), cetyl pyridinium bromide, and a bleaching agent to teeth with the aid of a tray. Jensen et al. differ from the instant invention in that Jensen et al. do not make claim to an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such invention.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8,10,11,13-19,23-26 of U.S. Patent No. 6309625. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent discloses a composition comprising a desensitizing agent (potassium nitrate, citric acid), a tackifying agent (carboxypolymethylene), cetyl pyridinium bromide, and a bleaching agent. USPN '625 does not require an abrasive. Jensen et al. differ from the instant invention in that Jensen et al. do not make claim to an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such invention.

Claims 41,42,44-48,50-54,56-63,65-68,70-87,91-93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6306370. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent discloses a method of applying a composition comprising a desensitizing agent (potassium nitrate, citric acid), a tackifying agent (carboxypolymethylene), cetyl pyridinium bromide, and a bleaching agent to teeth with the aid of a tray. Jensen et al. differ from the instant invention in that Jensen et al. do

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not make claim to an invention comprising 10-30% peroxide and 0.01% to 2% potassium nitrate. However, Jensen et al. do suggest such invention.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/

Primary Examiner, Art Unit 1616